

U.S. Patent Application Serial No. **10/566,202**
Response filed July 21, 2009
Reply to OA dated June 1, 2009

REMARKS

Claims 1-7 and 9-14 are pending in this application. No amendment is made in this Response. It is believed that this Response is fully responsive to the Office Action dated June 1, 2009.

Summary of telephone interview of July 1, 2009

On July 1, 2009, Applicant's agent, Daniel Geselowitz, telephoned Examiner Hess to ask for clarification of some of the Examiner's remarks in the Office action of June 1, 2009. Examiner Hess clarified these remarks, as discussed below in regard to the claim rejection.

Claims 1-7 and 9-14 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. (Office action p. 2)

The rejection of claims 1-7 and 9-14 is respectfully traversed, and reconsideration is requested.

The Examiner states that:

"In particular, the new recitation constitutes **new matter** since the limitations recited therein pertain to the specifics of the materials of Example 12 and the manner in which they are employed rather than the materials generically recited in the claims." (emphasis added).

By, "new recitation," the Examiner is presumably referring to the limitation added to claim 1 in the Amendment of February 27, 2009:

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"and wherein the ratio of the mass of hollow particles A (W_A) and that of hollow particles B (W_B) included in said intermediate layer satisfies the following relational formula (4):

$$W_B/W_A = 0.14 \text{ to } 1 \quad (4)."$$

The Examiner's comments regarding "Example 12" appear to refer to Applicant's indication that Example 12 provides support for that amendment (see page 10 of the Amendment of February 27, 2009).

In traversing the rejection, Applicant generally disagrees with the Examiner's comment that limitations that "pertain to the specifics of the materials of Example 12" "constitute[s] new matter," since an example in the specification can generally provide support for a new claim limitation.

Applicant found the Examiner's phrase "rather than materials generically recited in the claims" to be unclear, since it was not clear which claims or which materials are being referred to, and the meaning of the word "generically" was also unclear to Applicant. Applicant's agent telephoned Examiner Hess on July 1, 2009, for clarification. The Examiner explained that his meaning was that the amendment to claim 1 added only one limitation found in Example 12, but did not add **all** of the limitations of claim 12. The Examiner referred to this as "extracting" a limitation from claim 12, and he considered this to be improper.

However, Applicant submits that the limitation added in the last amendment is fully supported by the specification and by applicable case law.

The issue here is therefore whether the specific limitation of the ratio W_B/W_A to the range of "0.14 to 1" recited in claim 1 is supported by the specification, in particular by Example 12 (Table 2 on page 62), which is an example with a value of 0.14, and in the disclosure on page 24, line 15, of an upper value of 1.

Applicant submits that the disclosure on page 24, lines 14-15, of the substitute specification clearly indicates that the ratio " W_A/W_B " is a parameter subject to limitation, and this portion of the specification provides two possible ranges for this parameter: "0.001 to 1" and "0.003 to 0.008." Therefore, there is clearly support in general for a limitation on the parameter " W_A/W_B " and for the upper limit of "1" for this parameter.

MPEP 2163.05 discusses changes to the scope of a claim, and MPEP 2163.05(III) specifically deals with range limitations. In particular, in the case of *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), one range limit was found to be supported by a specific example in the specification. In the application at issue in *In re Wertheim*, the specification disclosed a range of "25%-60%" and there was an example of "36%." The limitation "between 35% and 60%" was found to meet the written description requirement.

Applicant submits that the present situation is completely analogous to that in *In re Wertheim*. In *In re Wertheim*, a range limitation was found to be supported by an upper limit of a specifically disclosed range, and a lower limit based on one example. Similarly, in the present application, the explicitly disclosed range of "0.001 to 1" supports the upper limit of "1," and the disclosed example of "0.14" supports the lower limit of "0.14."

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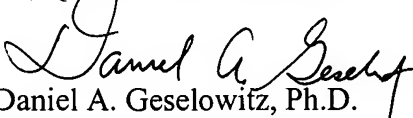
The case of *In re Wertheim* therefore supports Applicant's position that the written description for claim 1 is fully met. Withdrawal of the rejection is respectfully requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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